

Dean L. Engelhardt, et al., Serial No.: 08/479,997 (Filed June 7, 1995)
Page 27 [Second Supplemental Amendment (Following Applicants' September 3,
2004 Amendment Under 37 C.F.R. §1.116) -- March 30, 2005]

REMARKS

After entry of the complete listing of the claims provided above:

Claims presently pending: Claims 956-961, 964-968, 970-976, 978-993, 996-1000, 1002-1009, 1011-1027, 1030-1034, 1036-1042, 1044-1059, 1062-1066, 1068-1075 and 1077-1087.

Claims currently amended: Claims 956, 972, 985, 987-988, 1005, 1008, 1018, 1020, 1022, 1038, 1051, 1053-1054, 1071, 1084 and 1086.

Claims presently canceled: Claims 1-955,¹ 962-963, 969, 977, 994-995, 1001, 1010, 1028-1029, 1035, 1043, 1060-1061, 1067, 1076 and 1088-1227.

Claims presently added: None.

Entry of the above claim listing and claim amendments is respectfully requested.

Applicants wish to thank Group 1600 Director Bruce M. Kisliuk, Supervisory Patent Examiner Ardin H. Marschel, Ph. D, and Training Quality Assurance Specialists Michael Woodward, Ph.D. and Bonnie L. Eyler, for the courtesy and time they extended to Applicants' undersigned attorney and their three legal representatives, Robert M. Schulman, Esq., David A. Kelly, Esq. and Jeffrey T.

¹ It should be noted that in Applicants' April 23, 2004 Amendment Under 37 C.F.R. §1.115, claims 1-825 were indicated as being canceled. Thus, claims 826-955 are currently being canceled in this paper.

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Perez, Esq., during the March 29, 2005 phone interview. The filing of this paper follows the substance of that interview.

Summary of March 29, 2005 Interview

The Group 1600 personnel and Applicants' attorney and representatives discussed the March 24, 2005 Advisory Action, in which the Examiner declined to enter the amendments presented in Applicants' December 28, 2004 Supplemental Amendment Under 37 C.F.R. §1.116, and he reiterated the rejections made in the July 14, 2004 Final Office Action. Applicants' December 28, 2004 Supplemental Amendment had included several changes to the claims in light of the December 16, 2004 interview held with Examiners Marschel and Woodward. The changes included the deletion in independent claims 956, 988, 1022 and 1054 of the phrase "and wherein said Sig comprises a non-polypeptide, non-nucleotidyl, non-radioactive label moiety which can be directly or indirectly detected when attached to PM or when said modified nucleotide is incorporated into said oligo- or polynucleotide or when said oligo- or polynucleotide is hybridized to said complementary nucleic acid of interest or a portion thereof." The deletion of that preceding phrase was made in order to overcome the Examiner's new matter rejection. According to the March 24, 2005 Advisory Action, however, it was indicated that the amendments would not be entered because they "would raise new issues that would require further consideration and/or search due to seriously broadening the claims via deletion of the Sig characteristics limitations, such as 'non-polypeptide', 'non-nucleotidyl', and 'non-radioactive'."

In the March 29, 2005 interview, agreement was reached that reinstatement of the deleted phrase above, except for the word "non-nucleotidyl," would not raise new issues requiring further consideration and/or search. The Group 1600

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personnel agreed that such an amendment would overcome the new matter rejection, thereby reducing issues for appeal. The Group 1600 personnel also agreed that Applicants' other claim amendments presented in their December 28, 2004 Supplemental Amendment overcame the enablement and indefiniteness rejections set forth in the July 14, 2004 Office Action.

Accordingly, it was agreed that Applicants would file a further Supplemental Amendment substantially identical to their December 28, 2004 Supplemental Amendment, except that independent claims 956, 988, 1022 and 1054 would now recite "and wherein said Sig comprises a non-polypeptide, non-nucleotidyl, non-radioactive label moiety which can be directly or indirectly detected when attached to PM or when said modified nucleotide is incorporated into said oligo- or polynucleotide or when said oligo- or polynucleotide is hybridized to said complementary nucleic acid of interest or a portion thereof." In turn, Examiner Marschel agreed to state in an interview Summary that such an Amendment would be entered for purposes of appeal. As such, the only issue remaining on appeal would be the prior art rejections of record.

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SUMMARY AND CONCLUSIONS

A complete listing of all claims, including pending claims 956-961, 964-968, 970-976, 978-993, 996-1000, 1002-1009, 1011-1027, 1030-1034, 1036-1042, 1044-1059, 1062-1066, 1068-1075 and 1077-1087, is provided above in accordance with the substance of the March 29, 2005 Interview, also discussed above.

No claim fee is believed due for presenting the claim listing above, the number of pending claims being less than the highest number of previously paid for claims. Because a Notice of Appeal was filed concurrently with Applicants' September 3, 2004 Amendment Under 37 C.F.R. §1.116, a Request For Extension Of Time (3 additional months) is also being filed concurrently with this paper.

The Patent and Trademark Office is hereby authorized to charge the requisite three month extension fee of \$1,710.00 to Deposit Account No. 05-1135. No other fees are believed due for filing this paper. In the event that any other fee or fees are due, however, authorization is hereby given to charge the amount of any such fee(s) to Deposit Account No. 05-1135, or to credit any overpayment thereto.

If a telephone conversation would further the prosecution of the present application, Applicants' undersigned attorney request that he be contacted at the number provided below.

Respectfully submitted,



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